

Appl. No. 10/813,873
Response dated October 2, 2008
Reply to Office Action of July 2, 2008

Remarks

Claims 1-24 are presented for Examiner Rodgers' consideration. Pursuant to 37 C.F.R. § 1.111, Applicants respectfully request reconsideration of the present claims in view of the following responses.

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Response to Rejections

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The application of the "teaching, suggestion, or motivation" (TSM) test is not "rigid." However, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (emphasis added).

By way of the Office Action mailed July 2, 2008, claims 1-3, 5, 7-8, 11-13, and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,766,389 to Brandon et al. (hereinafter "Brandon") and further in view of U.S. Patent No. 5,503,076 to Yeo (hereinafter "Yeo") This rejection is respectfully traversed.

Applicants' claims 1 and 22 are directed to two-step printing. Specifically, claims 1 and 22 require, *inter alia*, contact printing at least one first graphic on a moving substrate and non-contact printing at least one second graphic on the same moving substrate. Neither Brandon nor Yeo, alone or in combination, teach or suggest these claim limitations.

The Examiner asserts that Brandon teaches a method of printing a moving substrate. Applicants respectfully disagree. Brandon teaches a process and apparatus for assembling training pants, not printing. (col. 10: ll. 9-11). Brandon teaches using pre-printed material (col. 6: ll. 48-51) and states that graphics can be provided in any suitable manner (col. 12: ll. 25-27). However, there are no specifics in Brandon regarding printing and thus Brandon does not teach two step printing using both contact printing and non-contact printing on the same substrate as required by the claims.

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The Examiner further asserts that it would have been obvious to modify the method of printing a moving substrate as taught by Brandon to include contact and non-contact printing as taught by Yeo. Applicants acknowledge that Yeo discloses contact printing and non-contact printing. However, Yeo does not disclose contact printing a first graphic on a substrate in a first converting operation and non-contact printing a second graphic on the same substrate in a second converting operation as claimed.

Thus, no prima facie case of obviousness has been established because the prior art references, alone or in combination, do not teach or suggest all the claim limitations. Applicants respectfully request that the rejection of claims 1, 22, and those claims depending therefrom be withdrawn for at least this reason.

Claim 5 further requires, *inter alia*, that the substrate be moving at least 100 feet per minute during the non-contact printing. The Examiner cites column 10, lines 41-42 and column 9, lines 7-10 of Yeo to reject this claim. Applicants respectfully note that reference in column 10 refers to contact printing in connection with the 100 feet per minute. The reference in column 9 to ink jet printing does not disclose a speed. Thus, no prima facie of obviousness has been established regarding claim 5 for at least this additional reason.

By way of the Office Action mailed July 2, 2008, claims 14-17 and 21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Yeo and further in view of U.S. Patent No. 6,297,424 to Olson et al. (hereinafter "Olson"). This rejection is respectfully traversed.

Applicants' claims 14 and 21 are directed to two-step printing. Specifically, claims 14 and 21 require, *inter alia*, contact printing at least one first graphic on a moving substrate (outercover in claim 21) and non-contact printing at least one second graphic on the same moving substrate (outercover in claim 21).

The Examiner asserts that "Yeo teaches...contact printing a least one first graphic (figure 3)...non-contact printing at least one second graphic [figures 1 and 3...] on the outer cover in the second printing operation using an ink jet printer...." (Office Action at

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pages 4 and 5). Applicants note that there is no support for the implication that figures 1 and 3 of Yeo were non-contact printed. Furthermore, as discussed above, Yeo fails to teach contact printing a first graphic on a substrate in a first converting operation and non-contact printing a second graphic on the same substrate in a second converting operation as claimed. Olson was added for teaching a "first graphic spanning at least 60% of the width" and not to cure this defect.

Thus, no prima facie case of obviousness has been established for claims 14, 21, and those claims depending therefrom. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

By way of the Office Action mailed July 2, 2008, claims 4, 6, 9, and 10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Brandon and Yeo, according to claim 1, as referenced above, and further in view of Olson. This rejection is respectfully traversed.

Claims 4, 6, 9, and 10 depend from claim 1 and are patentably distinct over Brandon, Yeo and Olson for the reasons stated above. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

By way of the Office Action mailed July 2, 2008, claims 18-20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Brandon and Yeo and further in view of Olson. This rejection is respectfully traversed.

Applicants' claims 18-20 are directed to two-step printing. Specifically, claims 18-20 require, *inter alia*, contact printing at least one first graphic on a moving substrate and non-contact printing at least one second graphic on the same moving substrate. As discussed above, neither Brandon nor Yeo, alone or in combination, teach or suggest these claim limitations. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection for at least this reason.

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Furthermore, Applicants' claims 18-20 also require, *inter alia*, printing a plurality of "absence advertisements". The Examiner asserts that Olson teaches printing with absence advertisements and cites column 3, line 67 for support. Applicants acknowledge that Olson uses the word "advertisement" but Applicants respectfully disagree that Olson teaches printing "absence advertisements" as that phrase is used in the present application. Specifically, an "absence advertisement" is a graphic that conveys the message that an additional graphic is missing. (See e.g., the sentence bridging pages 20 and 21). The Examiner has not cited any reference that teaches a graphic that conveys the message that an additional graphic is missing. Thus, no prima facie case of obviousness has been established for at least this additional reason.

By way of the Office Action mailed July 2, 2008, claim 23 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Brandon and Yeo and further in view of Olson. This rejection is respectfully traversed.

Claim 23 depends from claim 22 and is patentably distinct over the combination of Brandon, Yeo, and Olson for the same reasons as discussed above. Applicants respectfully request that this rejection be withdrawn.

By way of the Office Action mailed July 2, 2008, claim 24 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Brandon and Yeo and further in view of Casagrande. This rejection is respectfully traversed.

Claim 24 depends from claim 22 and is patentably distinct over the combination of Brandon and Yeo for the same reasons as discussed above. Specifically, Brandon and Yeo do not disclose contact printing a first graphic on a substrate in a first converting operation and non-contact printing a second graphic on the same substrate in a second converting operation as claimed. Casagrande was added for the element of "customized graphics", not to cure this defect. Thus, no prima facie case of obviousness has been established for at least this reason. Applicants respectfully request that this rejection be withdrawn.

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For the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-3016.

Respectfully submitted,

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